

## **REMARKS**

This amendment is in response to the office action dated February 27, 2002. In the office action, claims 1-15 and 18-20 were allowed, and claims 16-17 were rejected. A detailed discussion of each item in the office action follows.

### **THE 102(b) REJECTION**

In items 1-2 of the office action, claims 16-17 were rejected under 35 U.S.C. 102(b) as being anticipated by Wiedemann. Applicant's Attorney believes that the claims, as amended, are not anticipated by Wiedemann for the following reasons:

Wiedemann does not anticipate Applicants' invention for the following reasons, as explained more fully above:

1. Wiedemann is not known or capable of performing the function of this invention, nor does it teach the disclosure of this invention.
2. Wiedemann does not disclose the purpose, means or mechanism that this invention discloses.
3. Wiedemann does not solve the problems that this invention solves.
4. Wiedemann does not disclose each and every element of this invention.
1. **Wiedemann is not known or capable of performing the function of this invention, nor does it teach the disclosure of this invention.**

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There is not anticipation by a prior patent not known or recognized as being capable of performing the function of the patented device, but rather the prior patent must itself do the teaching. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 U.S.P.Q. 385 (1984); Edstrom-Carson & Co. v. Onsrud Machine Works, Inc., 129 U.S.P.Q. 457.

Wiedemann is not capable of functioning the same as this invention because:

Wiedemann is designed for use in an environment where multiple stations simultaneously broadcast the same program. In areas where broadcast signal quality is marginal, the Wiedemann system provides for the same programs to be simultaneously broadcast from multiple transmitters using multiple frequencies. When the signal quality drops below an acceptable level, Wiedemann selects another station broadcasting the same program. The Wiedemann system relies on the broadcast signal it is receiving to provide it with a list of other stations broadcasting the same program. In particular, Wiedemann states:

“During reception, the data of the frequencies alternative to that of the currently received transmitter, which data were communicated in coded form by the transmitter and were acquired by the RDS demodulator are filed in the temporary memory.” (Col 3, lines 25-30)

At selected intervals, Wiedemann uses the RDS demodulator to scan only those frequencies which are broadcasting the same program, and only for the purpose of determining the transmitter with the strongest signal. In particular, Wiedemann states:

“... controller 19, by means of the seconds oscillator 8, tunes the second mixer 4 successively to the stored alternative frequencies carrying the same program signal. The values then determined respectively from the field strength and from the amplitude-demodulation components for the reception quality are also temporarily stored.” (Col 3, lines 46-53)

and

“If the quality of the reception from the transmitter being detected by the two antennas drops below a predesignated or predetermined satisfactory level, controller 19, by means of the first oscillator 6, tunes the two mixers 3, 4 to the alternative frequency having the reception quality that was determined beforehand to be the optimum.” (Col 3, lines 56-63)

Wiedemann's function, as described by Wiedemann, is directed to a system in which the same program is simultaneously broadcast over multiple frequencies by multiple stations. A list of stations carrying that programs is also encoded in the broadcast signal and stored in memory by Wiedemann. The second tuner in Wiedemann is only used to test each of those frequencies on the broadcast list to see which one has the best signal strength. The station with the best signal is then selected for use.

The foregoing function, which Wiedemann performs, is only related to signal strength optimization when the same program is broadcast via a multi-station/multi-frequency platform. Its benefit to a user is that the user can listen to a program, while the radio automatically switches frequencies to improve the sound quality of that particular program. The switching is transparent to the user.

The function of Applicant's invention is wholly different. It is directed to the creation of a list of individual recorded works for which the user has a preference. Applicant's second tuner does not maintain a list of frequencies for the program which is currently being played. Rather, it scans frequencies to see if any station is broadcasting any desired recorded work which is on the list created by the user. It uses data which is broadcast as part of that recorded work, and which contains embedded information that identifies that particular recorded work, to determine if the program being played should be interrupted so that the desired work can be played instead.

As can be seen, Wiedemann's invention is used to play the same program with the best quality audio, while Applicant's invention is used to locate desired alternatives to the program being played, so that the user can switch to that desired program. The functions embodied by the Wiedemann invention, and by Applicant's invention, are therefore entirely different.

2. **Wiedemann does not disclose the purpose, means or mechanism that this invention discloses.**

There is no anticipation where a reference does not disclose the purpose, means and mechanism for accomplishing the instant invention but rather is restricted to a limited and different means. Sperry Products, Inc. v. Alluminum Company of America, 120 U.S.P.Q. 362.

As discussed above, the goals or objects of Applicant's invention, without limitation, are to allow the user to dynamically switch stations when a particular selection, which the user desired to hear, is broadcast on another station.

Wiedemann cannot meet these objects to the extent that Applicant's invention can, because Wiedemann neither teaches nor suggests that a list of individual recording can be maintained for use by a scanning engine that dynamically switches programs based on the program content. Wiedemann, in fact, teaches away from this by teaching how to optimize sound quality while remaining tuned to the same program.

3. Wiedemann does not solve the problems that this invention solves.

There is no anticipation if a prior patent does not solve the problem(s) which the subsequent patent successfully solves. Technical Development Corporation v. Servo Corporation of America, 125 U.S.P.Q. 133.

Applicant's invention solves a problem which results from the availability of the many alternative broadcast channels in most areas. In particular, a user may prefer to listen to many recorded works. However, due to the number of channels, and the inconvenience of manually "surfing" the available channels, the user will often just listen to whatever is on rather than search for those preferred works. Applicant's invention removes this burden by automatically scanning stations for preferred works, without requiring any action by the listener.

There is no suggestion anywhere in Wiedemann that this is a problem, and Wiedemann does not suggest scanning for content to allow a listener to switch to a more desirable program. Wiedemann is solely focused on the optimization of the sound quality of the program which the user is currently listening to. As such, Wiedemann does not solve the problem that Applicant's invention solves.

4. **Wiedemann does not disclose each and every element of this invention.**

There is no anticipation if the reference does not disclose each and every element of the claimed invention. SSIH Equipment S.A. v. United States International Trade Commission, 718 F.2d 365, 218 U.S.P.Q. 678 (1983).

Wiedemann does not disclose a list of preferred individual recorded works, or a means to identify when and where a particular recorded work is being broadcast, or a means to switch stations to listen to that preferred work. Wiedemann merely stores a list of stations broadcasting the same program it is currently listening to, so that the currently selected program can be listened to with the best quality sound.

For all the reasons set forth above, Applicant's invention is not anticipated by the Wiedemann reference.

To more clearly define Applicant's invention over that taught by Wiedemann, independent claim 16 has been amended to more particularly describe the differences discussed above. If claim 16 is held allowable, then claim 17, which depends from independent claim 16, should also be allowable.

**THE ALLOWABLE SUBJECT MATTER**

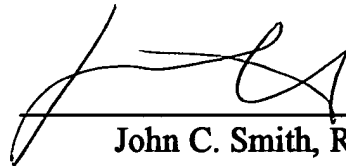
Regarding item 3 of the office action, the Examiner indicated that claims 1-15 and 18-20 are allowed.

## CONCLUSION

Applicant's Attorney thanks the Examiner for the Examiner's help in prosecuting this invention. In response to the office action, Applicants' Attorney has amended claim 16. Applicant's Attorney has been careful to avoid the introduction of new matter. A separate petition and fee for a two month extension of time is attached. Applicant's Attorney believes that all items in the office action have been addressed, and respectfully requests the Examiner to reconsider the claims, as amended, with a view towards allowance.

Respectfully submitted,

By:



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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Box Fee Amendment, Assistant Commissioner for Patents, Washington, D.C. 20231

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Date of Deposit

  
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Signature Date